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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,017	06/30/2000	Jay S. Walker	00-055	2125

22927 7590 08/12/2003

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/609,017	WALKER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 May 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 3-14,26-29 and 36-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 3-14,26-29 and 36-51 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 3-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

As per claims 3-14, 34-35 and 39-51, they are confusing, because the scope of the claims is not clear.

The method step “receiving a signal” is not descriptive. It is not clear what does the term “signal” encompass. Also, neither signal-producing means, no signal-receiving means are indicated, therefor it is not clear what does the term “receiving” imply.

The method step “determining whether a first container for storing a first medicine was positioned so as to wirelessly communicate with a second container for storing a second medicine based at least in part on the signal” is confusing, because it is not clear what does the term “determining” contemplate. Also, the use of the terms “a first container for storing a first medicine” and “a second container for storing a second medicine” is confusing, because these terms were not defined prior to said method step.

The method step “determining a level to which a party complied with a medicine schedule based on the information (signal)” is confusing, because it is not indicated if the party took this medicine. Also, it is not clear what does the term “information (signal)” encompass (See above).

As per claims 26-29, they are confusing, because they reffer to an apparatus while describing method steps.

As per claims 36-37, they are confusing, because they reffer to a computer program product while describing method steps.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 3-14, 34-35 and 39-51 are rejected under 35 U.S.C. 101 because the claimed method for rewarding a party does not recite a limitaion in the technological arts.** The independently claimed steps of: receiving information; determining a level to which the party complied with a medicine schedule; and rewarding the party, are abstract ideas which can be performed mentally without interaction of a physical structure. Because the independently claimed invention is directed to an abstract idea which does not recite a limitaion in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3-14, 26-27 and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,950,632) in view of Andrews (US 5,757,271).**

As per claims 3-5, 11 and 26, Reber et al. teach a system and method for medical communication apparatus, comprising:

- receiving the signal from a device that monitors whether the first container and the second container are positioned so as to wirelessly communicate (column 2, line 41 through column 6, line 53);
- determining whether a first container for storing a first medicine was positioned so as to wirelessly communicate with a second container for storing a second medicine based at least in part on the signal (column 2, line 41 through column 6, line 53).

However, Reber et al. do not teach that the first container wirelessly communicates with the second container.

Andrews teaches a system and method for providing security for an electronic device wherein a first portable security device wirelessly communicates with a second portable security device to determine whether or not the second security device is within a selected proximity of the first security device (Abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Reber et al. to include that the first container wirelessly communicates with the second container because it would enhance the security of the

system and increase accuracy of determining compliance of the patients with the prescribed schedule of taking medicine.

As per claim 6, Reber et al. teach said system and method wherein receiving the signal from a device that monitors whether the first container and the second container are positioned so as to wirelessly communicate comprises polling the device (column 3, lines 9-34; column 7, lines 55-59; column 10, lines 47-48).

As per claim 7, Reber et al. teach said system and method wherein receiving a signal comprises receiving a signal from at least one of a representative of a pharmacy, a representative of a medical facility and a party that is to take at least one of the first and the second medicines (column 3, lines 9-25; column 7, line 60 through column 10, line 54).

As per claim 8-10, Reber et al. teach said system and method wherein receiving a signal comprises receiving an encrypted code (column 4, lines 23-26; column 7, lines 11-42; column 9, lines 54-65).

As per claims 12, 27 and 39-40, Reber et al. teach said system and method, comprising determining if at least one party has complied with a schedule for taking the first medicine and the second medicine based at least in part on the received signal (column 7, line 60 through column 10, line 54).

As per claims 13 and 41-42, Reber et al. teach said system and method wherein determining if at least one party has complied with a schedule for taking the first medicine and the second medicine based at least in part on the received signal comprises:

- receiving first information regarding a prescribed schedule for taking the first medicine and the second medicine (column 9, line 51 through column 10, line 54);
  - receiving second information regarding a schedule for taking the first medicine and the second medicine adhered to by the at least one party (column 9, line 51 through column 10, line 54);
    - comparing the first information to the second information (column 9, line 51 through column 10, line 54);
      - generating at least an indicator of a level to which the at least one party has complied with a schedule for taking the first medicine and the second medicine (column 9, line 51 through column 10, line 54).

As per claim 14, Reber et al. teach said system and method wherein obtaining first information regarding the first medicine and the second medicine comprises obtaining the first information from at least one of a representative of a pharmacy, a representative of a medical facility and a representative of a manufacturer of at least one of the first and the second medicines (column 3, lines 9-25, column 7, line 60 through column 10, line 54).

**Claims 28-29, 34-38 and 43-44, 46-48 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. and Andrews in view of Brown (US 6,151,586).**

As per claims 28-29, 34-36, 38, 43-44, 47 and 51, Reber et al. and Andrews teach all the limitations of claims 28-29, 34-36, 38, 43-44, 47 and 51, except for a

server adapted to: receive the data output by the compliance monitoring device; and reward at least one party based on the received data.

Brown teaches teaches a computerized reward system and method for encouraging in a health management program, comprising a server for receiving the compliance data, and wherein a compliance data on individuals is evaluated, and the reward to be given to the compliant individual (Abstract; column 3, lines 18-60).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Reber et al. and Andrews to include a server adapted to receive the data output by the compliance monitoring device; and rewarding a party based on the compliance data, because it would enhance the capability of the system, and stimulate patients to comply with health management program thereby allowing physicians to determine the best way of treatment for the patients more accurately.

As per claim 37, Brown teaches said system and method wherein the reward comprises a discount on a product (Abstract; column 23, lines 46-57).

As per claim 46, Reber et al., Andrews and Brown disclose all the limitations of claim 46, except that rewarding for complying with the schedule comprises providing the at least one party with a reward selected by at least one of a representative of an insurance company and a representative of a medical facility.

It would have been an obvious matter of design choice to modify Reber et al., Andrews and Brown to include that rewarding for complying with the schedule comprises providing the at least one party with a reward selected by at least one of a representative of an insurance company and a representative of a medical facility,

because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Reber et al., Andrews and Brown would perform the invention as claimed by the applicant with any third party to select a reward.

As per claim 48, Reber et al., Andrews and Brown disclose all the limitations of claim 48, except that a first reward based on a distance between the first container and the second container, and a second reward based on at least one other indicator that the at least one party has complied with the schedule for taking the first medicine and the second medicine. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Reber et al., Andrews and Brown to include that a first reward based on a distance between the first container and the second container, and a second reward based on at least one other indicator that the at least one party has complied with the schedule for taking the first medicine and the second medicine, because it would stimulate and discipline patients to comply with health management program thereby allowing physicians to determine the best way of treatment for the patients more accurately.

**Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al., Andrews and Brown in view of Bro (US 5,722,418).**

As per claim 45, Reber et al., Andrews and Brown teach all the limitation of claim 45, except for providing the at least one party with a list of rewards; receiving a selection of one of the listed rewards; and providing the selected reward to the at least one party.

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Bro teaches a system and method for mediating social and behavioral processes in medicine wherein a patient lists rewards he would receive for his behavior (column 41, lines 3033).

It would have been obvious for one having ordinary skill in the art at the time the invention was made to modify Reber et al., Andrews and Brown to include providing the at least one party with a list of rewards, because it would stimulate patients to comply with health management program thereby allowing physicians to determine the best way of treatment for the patients more accurately.

**Claims 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al., Andrews and Brown in view of Daansen et al. (US 6,375,038).**

As per claims 49 and 50, Reber et al., Andrews and Brown teach all the limitations of claims 49 and 50, except for penalizing the at least one party if the at least one party has not complied with the schedule.

Daansen et al. teach a system and method for promoting compliance with proper washing techniques, wherein employers may be fined if employees do not comply with Food Code regulations (Abstract; column 1, line 54 through column 2, line 16).

It would have been obvious for one having ordinary skill in the art at the time the invention was made to modify Reber et al., Andrews and Brown to include penalizing a party or charging the party for at least the portion of a treatment if the party has not complied with the schedule, because it would discipline patients to comply with health

management program thereby allowing physicians to determine the best way of treatment for the patients more accurately.

***Response to Arguments***

Applicant's arguments filed 05/08/03 have been fully considered but they are not persuasive.

In response to applicant's argument that sited references do not disclose communication between medicine containers, examiner points out that this feature was disclosed by a combination of Reber et al. in view of Andrews, wherein Reber et al. shows medical containers including a circuitry for wireless communication, and Andrews shows wireless communication between two portable devices to determine whether or not the second portable device is within a selected proximity of the first portable device (See discussion above).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, both Reber et al. and Andrews relate to computerise devices including a housing or a container, and wireless communication circuitry allowing said devices to communicate with similar devices. Brown teaches a computerise device

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including a wireless communication circuitry, and was applied for compliance evaluation and rewarding based upon said compliance evaluation (See discussion above).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 305-7687** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

IB

*[Signature]*  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
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